

REMARKS

Claims 11-20 are pending within the present application. Claims 1-10 have been canceled. No Claims have been amended. The new claims merely require that the black offset inks be oil-based, as taught throughout the specification, including the examples. The modification of the term "printed substrate" has been made to read just "substrate" and, in accordance with the request of the Office, the limitation of "a portion of which" has been modified to clarify the target substrate. No new matter has been added. Thus, entry and due consideration of these amendments are therefore respectfully requested. Such an amendment also renders moot the previous indefiniteness rejection.

The Office rejected Claims 1-8 under 35 U.S.C. § 102(b) as being anticipated by Titterington et al. as well as EP 936257. Applicant has chosen to respond to these bases of rejection in kind since the basic teachings are extremely similar. In essence, Applicant disagrees with such rejections as the current claims require an oil-based black offset ink (as taught throughout the specification) and because the teachings of the cited prior art references simply do not teach the same claimed subject matter of the present application. Both cited references are limited to ink jet inks, wherein the inks are provided in stick form for melting during use (i.e., as waxes, for example). There are no oil-based teachings or requirements anywhere within these disclosures, let alone specific offset inks. Thus, there is no anticipation over the pending claims. Likewise, there can be no proper obviousness over the pending claims since there is no motivation provided by these patents to modify the ink jet inks to meet the same limitations as

now claimed.

Of equal importance, however, is Applicant's position that the Office has misunderstood the teachings of the prior art. There is no anticipatory teaching over the pending claims, let alone the previously pending claims, provided by these references. Where is the clear specific disclosure of an ink of any type including a black pigment and a toner component as now claimed that exhibits the chromatic characteristics listed within the claims and which remains black in color? Applicant fails to find such a teaching anywhere within these cited patents. As such, anticipation is clearly nonexistent in this instance. The claims require a toned black offset ink that includes a black pigment in sufficient amount and a toner component that imparts the chromatic characteristics to the overall black ink after drawing down. Such a specific invention is not provided by the two cited references. These two disclosures are limited to the production of phase-change inks made from the reaction product of an already-produced colorant with an isocyanate, alkoxylated compound, and alcohol. The ability to change from one state to another through reaction of the pendant groups present on such a reaction product is the aim of the patentees in both instance. There is no toning provided by a compound to black pigments taught within these references, not to mention any offset inks that include such required components and exhibit the chromatic characteristics as now claimed. Again, said claims require a black offset ink comprising both a pigment and a toner, wherein the ink itself exhibits certain chromatic characteristics when drawn-down. Titterington et al. and the EP reference both teach the production of certain resinous structures that are colored. Such resins are then employed as colorants to produce certain colors and hues on substrates through printing. There is no

discussion of a required oil solvent or toned black pigment component anywhere within this reference, nor is there any indication that a toner compound is present anywhere within patentees' formulations, compositions, inks, etc. Applicant has produced and claimed an improved toned black offset ink composition that exhibits highly improved chromatic properties in terms of a black appearance through the presence of such specific toning components. Both references fail to mention any ability to introduce or otherwise utilize their resinous colorants as toning additives within any other colorant formulations, let alone as toner compounds for black pigments within specific offset ink compositions. Thus, the Office has not taken into account the requirements of the present claims, and has overstated the teachings of the cited prior art in order to determine that Titterington et al. and/or the EP reference have somehow anticipated the pending claims. It is evident, as a result, that the Office has exercised improper hindsight reconstruction of Applicant's own teachings in order to formulate such a basis of rejection. Reconsideration and withdrawal of such a rejection are thus earnestly solicited.

CONCLUSION

In view of all of the previous remarks and amendments, it is respectfully submitted that the pending claims are now in condition for allowance and it is requested that this application be passed on to issue.

Respectfully submitted,

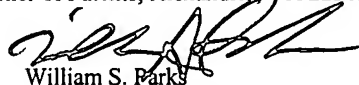
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